

- 5 -

Application No. 10/658,746
Docket No. 033171-30REMARKS

By the above actions, the claim 1 has been amended. In view of the action taken and the following remarks, further consideration of this application is now requested.

With regard to the rejections under 35 USC § 112, it is submitted that the above amendments address all of the points raised by the Examiner so that claim 1 is now both clear and definite as well as fully consistent and supported by the specification. Accordingly, the rejections under § 112 should now be withdrawn and such action is hereby requested.

The Examiner has rejected of claims 1-3 and 10-12, i.e., all of the claims to the elected embodiment based on the disclosure of the published application of Herta et al. when viewed in combination with the patent to Saperstein, either by themselves or in further combination with the patent to Baier and optionally also the patent to Brocx. These rejections are inappropriate insofar for the following reasons.

Firstly, as noted in applicants' last response, the Herta et al. publication is the prior art mentioned in paragraph [0002] of this application having the disadvantage noted in paragraph [0007] of the driver's bed or the rear wall of the cab having to be made technically complex because air is used as the heat transfer medium. This disadvantage is overcome, as noted in paragraph [0009] by the same heat transfer medium being transported by the heat source in order to directly heat the driver's bed or the interior wall of the vehicle and by the heat exchanger in the reservoir, in order especially to cool. In addition, the device of the present invention has the advantage that the driver's bed and/or the vehicle interior wall can also be heated out of the reservoir, specifically in the case in which the reservoir has to be charged beforehand with the thermal energy of the heat source by the heat exchanger. Still further, as can be seen from paragraphs [0042] through [0044] of the present application, the construction of the present invention enables over a dozen different operating modes to be produced using the same basic system.

As also indicated in the preceding response, the Herta et al. publication not only discloses, as already mentioned, a device which does not teach the use of a heating/cooling surface that is heated and cooled via a liquid heat exchange medium, but it is not capable of attaining all of the operating modes disclosed for the present invention. Even if a fan and heat exchanger unit of Herta et al. were replaced by plate heater as disclosed by Baier et al., was given the features of Saperstein indicated by the Examiner, it still would lack the capabilities

- 6 -

Application No. 10/658,746
Docket No. 033171-30

and versatility of the present invention, and even if, as the Examiner contends based upon Brocx, the use of a parallel arrangement of a main heat exchanger and sleeper unit is a recognized equivalent, such would not, by itself, lead to the present invention as defined by present claim 1. In this regard, it is relevant to note that, like the system of the Herta et al. reference, the systems of Baier et al. and Brocx are solely heating systems while that of Saperstein is solely a cooling system so that none of these three references can suggest how to modify the heating and cooling system of Herta et al. so as to attain the configuration disclosed and claimed by the present applicants.

Since claim sets forth the liquid nature of the heat exchange medium and the manners in which flows in the system can be controlled to attain a variety of different operations, it is submitted that the subject matter of amended claim 1 cannot be considered to be rendered obvious by the reference cited by the Examiner. In this regard, and in connection with the Examiner's comments concerning MPEP 2114 and his failure to give weight to the modes of operation that are claimed but not found in the references, it is submitted that, with regard to the "wherein said flow controllers are selectively operable to" clause added in applicants' preceding Amendment, the more relevant section of the MPEP is § 2173.05 which reads:

2173.05(G) FUNCTIONAL LIMITATIONS [R-3]

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. >In *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004), the court noted that the claim term "operatively connected" is "a general descriptive claim term frequently used in patent drafting to reflect a functional relationship between claimed components," that is, the term "means the claimed components must be connected in a way to perform a designated function." "In the absence of

- 7 -

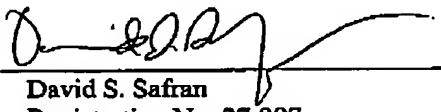
Application No. 10/658,746
Docket No. 033171-30

modifiers, general descriptive terms are typically construed as having their full meaning." *Id.* at 1118, 72 USPQ2d at 1006. In the patent claim at issue, "subject to any clear and unmistakable disavowal of claim scope, the term 'operatively connected' takes the full breath of its ordinary meaning, i.e., 'said tube [is] operatively connected to said cap' when the tube and cap are arranged in a manner capable of performing the function of filtering." *Id.* at 1120, 72 USPQ2d at 1008. [Emphasis Added.]

The highlighted language from the MPEP and court case cited therein makes it very clear that the Examiner cannot, as he has done, ignore the clear meaning of the last clause of claim 1 and must evaluate the prior art to determine if it renders obvious the provision of flow controllers that are selectively operable to produce the claimed flows. It is believed that the Examiner has at least tacitly recognized that the prior art does not render obvious flow controllers that are arranged and operable to produce all of the flows recited in claim 1 and thus, since a "functional limitation must be evaluated and considered, just like any other limitation of the claim," the outstanding rejection is not sustainable and should be withdrawn, such action being hereby requested.

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Respectfully submitted,

By: 

David S. Safran
Registration No. 27,997

Roberts Mlotkowski & Hobbes P.C
8270 Greensboro Drive
Suite 850
McLean, VA 22102

Direct Telephone: (703) 584-3273

DSS:kmm